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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,638

10/19/2006

Mitchell M. Jackson

3241-01

3878

26645

7590

04/15/2010

THE LUBRIZOL CORPORATION  
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EXAMINER

HINES, LATOSHA D

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

04/15/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,638	<b>Applicant(s)</b> JACKSON ET AL.	
	<b>Examiner</b> LATOSHA HINES	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This is the Final Office action based on the 10/595,638 application filed on 02 May 2006.
2. Claims 1-13 and 17-19 are pending and have been fully considered. Claims 14-16 are canceled and claims 17-19 are new.
3. The rejection under 35 USC 112 1st paragraph is withdrawn in light of Applicant's claimed amendments.
4. The rejection under 35 USC 112 2<sup>nd</sup> paragraph is withdrawn in light of Applicant's claimed amendments.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-13 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over CARABELL et al. (US 2003/0172582).

CARABELL et al. ["Carabell"] discloses in paragraphs [0025]-[0029], a fuel additive composition comprising a Mannich condensation product of (1) a high molecular weight alkyl-substituted hydroxyaromatic compound wherein the alkyl group has a number average molecular weight of from about 300 to about 5,000 (2) an amine, and (3) an aldehyde, wherein the respective molar ratio of reactants (1), (2), and (3) is 1:0.1-2:0.1-2.

Carabell discloses in paragraph [0056] that the preferred polyisobutenes used to prepare the presently employed polyalkyl hydroxyaromatic compounds are polyisobutenes which comprise at least about 20% of the more reactive methylvinylidene (high vinylidene) isomer, preferably at least about 50% and more preferably at least about 70% methylvinylidene isomer.

Carabell discloses in paragraph [0059] that the amine contains both a primary and a secondary amino group or two secondary amino groups. In paragraph [0064], Carabell discloses aldehydes such as formaldehyde used in the preparation of the Mannich.

Carabell discloses in paragraph [0033], a fuel composition comprising a major amount of hydrocarbons boiling in the gasoline or diesel range and an effective (minor) deposit controlling amount of a fuel additive composition. In paragraph [0034], Carabell discloses a fuel concentrate comprising an organic solvent. In paragraphs [0094] and [0095], Carabell discloses gasoline and diesel fuels containing fuel additives such as anti-knock agents, dispersants, and the like.

The examiner is of the position a reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545,549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it's realistically teachings and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

### ***Response to Arguments***

1. Applicant's arguments filed January 28, 2010 have been fully considered but they are not persuasive.

a. Applicant argued Carabell does not teach the PIB alkylated hydroxyaromatic compound derived by either: i) combining conventional PIB and high vinylidene PIB prior to the alkylation reaction, or ii) combining a hydroxyaromatic compound alkylated with conventional PIB and a hydroxyaromatic compound alkylated with high vinylidene PIB. However, the examiner disagrees. Carabell discloses in paragraphs [0052-0057] various types of PIB alkylated hydroxyaromatic compounds including polyisobutylphenol and polyisobutenephens containing a high percentage of methylvinylidene isomers. Carabell discloses in paragraph [0057], various mixtures of PIB, such as ULTRAVIS 10 which contains polyisobutylenes and high alkylvinylidene polyisobutylenes. Thus the examiner is of the position that the claimed Mannich

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condensates are taught by the prior art to Carabell. Additionally, it has been held that "It is *prima facie* obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

b. The Applicant argued unexpected results obtained by the use of a mixture of conventional PIB and high vinylidene PIB in the improvement of IVD (intake valve deposit) performance in gasoline engines. However, the examiner is of the position that the results shown in Applicant's specification are not commensurate in scope with the claimed invention for several reasons including that the claims are drawn to an additive composition and a fuel composition, and not to a method of use in a gasoline engine. Further, the claimed invention does not include any amounts of the components nor the specific Mannich condensates which set forth in the results/data supporting the improvement of IVD performance.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LATOSHA HINES whose telephone number is 571-270-5551. The examiner can normally be reached on Monday thru Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Marcheschi can be reached on 571-272-1374. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LATOSHA HINES/  
Examiner, Art Unit 1797

/Ellen M McAvoy/  
Primary Examiner, Art Unit 1797